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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/123,145	07/27/1998	KENZO SEKIGUCHI	1232-4458	5208

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MORGAN & FINNEGAN
345 PARK AVENUE
NEW YORK, NY 10154

EXAMINER

POKRZYWA, JOSEPH R

ART UNIT	PAPER NUMBER
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2622

DATE MAILED: 03/23/2004

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Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/123,145

Applicant(s)

SEKIGUCHI, KENZO

Examiner

Joseph R. Pokrzywa

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 05 December 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 43-46, 56 and 57 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 43-46, 56 and 57 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- ☐ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date 27/12-5-03.
- ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- ☐ Notice of Informal Patent Application (PTO-152)
- ☐ Other: _____.

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after allowance or after an Office action under *Ex Parte Quayle*, 25 USPQ 74, 453 O.G. 213 (Comm'r Pat. 1935). Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, prosecution in this application has been reopened pursuant to 37 CFR 1.114. Applicant's submission filed on 12/5/03 has been entered.

Information Disclosure Statement

2. The references listed in the Information Disclosure Statement submitted on 12/5/03 have been considered by the examiner (see attached PTO-1449).

Pending Claims

3. Upon reopening prosecution with the request for continued examination, **claims 43-46, 56, and 57** are pending.

4. The indicated allowability of **claims 43-46, 56, and 57** is withdrawn in view of the newly discovered reference(s) to Yamada (U.S. Patent Number 5,521,719), which was cited in the Information Disclosure Statement dated 12/5/03. Particularly, Yamada can be interpreted as teaching of receiving first instruction (being the SUB signal having procedure number code "04", "14", or "24") generated based on the message (CED message) returned by a returning means

(see Figs. 11-14), and receiving second instruction (being the SUB signal having a procedure number code "03", "13", or "23") indicating a facsimile communication without reception of the first instruction received by the first instruction reception step (see Figs. 11-14, whereby the procedure codes are different, therein not receiving the first instruction). Rejections based on the newly cited reference(s) follow.

Claim Rejections - 35 USC § 102

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

6. **Claims 43, 45, 46, 56, and 57** are rejected under 35 U.S.C. 102(b) as being anticipated by Yamada (U.S. Patent Number 5,521,719, cited in the Information Disclosure Statement dated 12/5/03).

Regarding **claim 43**, Yamada discloses a communication apparatus (apparatus 111, seen in Figs. 9 and 10) comprising means for connecting to a computer network (LAN I/F 123, column 14, lines 4 through 7), means for connecting to a public telephone network (facsimile communication unit 117, column 13, lines 36 through 63), facsimile reception means for receiving facsimile image data from a transmitting source via the public telephone network (see Fig. 10, and column 13, lines 37 through 63, and column 14, lines 52 through 62), returning means for returning a message (see Fig. 14, CED message) in response to a request (CNG message) received from the transmitting source via the public telephone network (see Figs. 3 and

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14, column 7, line 63 through column 9, line 26, and column 18, lines 47 through 58), first instruction reception means for receiving an instruction generated based on the message returned by the returning means (see Figs. 11-14, being the SUB signal, having procedure number code "04", "14", or "24", column 15, lines 20 through 25, column 16, lines 28 through 33, and column 17, lines 46 through 52), second instruction reception means for receiving an instruction indicating a facsimile communication without reception of the instruction by the first instruction reception means (see Figs. 11-14, being the SUB signal, having a procedure number code "03", "13", or "23", therein not receiving the first instruction, column 15, lines 13 through 19, column 16, lines 21 through 27, and column 17, lines 40 through 45), conversion means for converting the received facsimile image data into an e-mail data format (electronic mail/file transfer communication procedure controller 122, column 13, line 64 through column 14, line 4), processing means for processing the facsimile image data received by the facsimile reception means without performing the converting by the conversion means in a case where the second instruction reception means receives the instruction (column 15, lines 13 through 53, column 16, line 22 through column 17, line 8, and column 17, line 41 through column 18, line 16), and transmission means for transmitting the e-mail data converted by the conversion means in accordance with the instruction received by the instruction by one of the first and second reception means (column 15, lines 20 through 48, column 16, line 28 through column 17, line 3, and column 17, line 46 through column 18, line 24).

Regarding *claim 45*, Yamada discloses the apparatus discussed above in claim 43, and further teaches that the instruction reception means receives the instruction by a tone signal (column 7, line 63 through column 9, line 14).

Regarding *claim 46*, Yamada discloses the apparatus discussed above in claim 45, and further teaches that the tone signal is a DTMF signal (column 8, line 52 through column 9, line 14, and column 19, line 61 through column 20, line 23, wherein the PB signal, as well as the keyed input registered data, each would inherently be a DTMF signal).

Regarding *claim 56*, Yamada discloses a method for a communication apparatus (apparatus 111, seen in Figs. 9 and 10) comprising connecting to a computer network (via LAN I/F 123, column 14, lines 4 through 7), connecting to a public telephone network (via facsimile communication unit 117, column 13, lines 36 through 63), receiving facsimile image data from a transmitting source via the public telephone network (see Fig. 10, and column 13, lines 37 through 63, and column 14, lines 52 through 62), returning a message (see Fig. 14, CED message) in response to a request (CNG message) received from the transmitting source via the public telephone network (see Figs. 3 and 14, column 7, line 63 through column 9, line 26, and column 18, lines 47 through 58), receiving first instruction generated based on the message returned by a returning means (see Figs. 11-14, being the SUB signal, having procedure number code "04", "14", or "24", column 15, lines 20 through 25, column 16, lines 28 through 33, and column 17, lines 46 through 52), receiving second instruction indicating a facsimile communication without reception of the first instruction received by the first instruction reception step (see Figs. 11-14, being the SUB signal, having a procedure number code "03", "13", or "23", therein not receiving the first instruction, column 15, lines 13 through 19, column 16, lines 21 through 27, and column 17, lines 40 through 45), converting the received facsimile image data into an e-mail data format (electronic mail/file transfer communication procedure controller 122, column 13, line 64 through column 14, line 4), processing the facsimile image

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data received by a facsimile reception means without performing the converting by the conversion step in a case where the second instruction reception step receives the instruction (column 15, lines 13 through 53, column 16, line 22 through column 17, line 8, and column 17, line 41 through column 18, line 16), and transmitting the e-mail data converted by the conversion step in accordance with the instruction received by the instruction by one of the first and second instruction reception step (column 15, lines 20 through 48, column 16, line 28 through column 17, line 3, and column 17, line 46 through column 18, line 24).

Regarding *claim 57*, Yamada discloses a computer program for a communication apparatus (apparatus 111, seen in Figs. 9 and 10, column 13, lines 18 through 20) comprising computer readable program code means for connecting to a computer network (LAN I/F 123, column 14, lines 4 through 7), computer readable program code means for connecting to a public telephone network (facsimile communication unit 117, column 13, lines 36 through 63), computer readable program code means for receiving facsimile image data from a transmitting source via the public telephone network (see Fig. 10, and column 13, lines 37 through 63, and column 14, lines 52 through 62), computer readable program code means for returning a message (see Fig. 14, CED message) in response to a request (CNG message) received from the transmitting source via the public telephone network (see Figs. 3 and 14, column 7, line 63 through column 9, line 26, and column 18, lines 47 through 58), computer readable program code means for receiving first instruction generated based on the message returned by a returning means (see Figs. 11-14, being the SUB signal, having procedure number code "04", "14", or "24", column 15, lines 20 through 25, column 16, lines 28 through 33, and column 17, lines 46 through 52), computer readable program code means for receiving second instruction indicating

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a facsimile communication without reception of the first instruction received by the first instruction reception code means (see Figs. 11-14, being the SUB signal, having a procedure number code "03", "13", or "23", therein not receiving the first instruction, column 15, lines 13 through 19, column 16, lines 21 through 27, and column 17, lines 40 through 45), computer readable program code means for converting the received facsimile image data into an e-mail data format (electronic mail/file transfer communication procedure controller 122, column 13, line 64 through column 14, line 4), computer readable program code means for processing the facsimile image data received by the facsimile reception code means without performing the converting by the conversion code means in a case where the second instruction reception code means receives the instruction (column 15, lines 13 through 53, column 16, line 22 through column 17, line 8, and column 17, line 41 through column 18, line 16), and computer readable program code means for transmitting the e-mail data converted by the conversion means in accordance with the instruction received by the instruction by one of the first and second instruction reception code means (column 15, lines 20 through 48, column 16, line 28 through column 17, line 3, and column 17, line 46 through column 18, line 24).

Claim Rejections - 35 USC § 103

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

8. **Claim 44** is rejected under 35 U.S.C. 103(a) as being unpatentable over Yamada (U.S. Patent Number 5,521,719, cited in the Information Disclosure Statement dated 12/5/03) in view of Yamamoto *et al.* (U.S. Patent Number 5,767,985, cited in the Office action dated 4/22/03).

Regarding **claim 44**, Yamada discloses the apparatus discussed above in claim 43, but fails to specifically teach if the returning means returns the response message as voice guidance information. Yamamoto discloses a communication apparatus (fax unit 30) comprising means for connecting to a computer network (network 52), means for connecting to a public telephone network (telephone line 70), facsimile reception means for receiving facsimile image data from a transmitting source via the public telephone network (column 8, lines 1 through 55, wherein as is widely known throughout the art while using G3 facsimile protocol, the dialed destination address, or the telephone number of the fax unit 30, is used to connect to the fax unit 30, whereby information data or handshake data is then received, thereby receiving information data with destination address data from a transmitting source via a network), returning means for returning a message in response to a request received from the transmitting source via the public telephone network (step 106, being the guide message from the host unit being sent over the public telephone line 70, after the incoming call from the transmitting source, which is interpreted as the "request"), first instruction reception means for receiving an instruction

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generated based on the message returned by the returning means (being step 128, column 9, lines 21 through 40), second instruction reception means for receiving an instruction without reception of the instruction by the first instruction reception means (being step 122, column 8, line 66 through column 9, line 36), conversion means for converting the received image data into an e-mail data format (column 11, line 46 through column 12, line 67, and column 13, line 56 through column 14, line 21), processing means for processing the image data received by the facsimile reception means in a case where the second instruction reception means receives the instruction (step 126, column 9, lines 29 through 36), and transmission means for transmitting the e-mail data converted by the conversion means in accordance with the instruction received by the instruction by one of the first and second reception means (step 130, column 9, lines 21 through 40, whereby received data is decoded, as well as seen in Fig. 5 as “yes” to 256 and 262). Further, Yamamoto teaches that the means for returning returns the message as voice guidance information (column 8, line 62 through column 9, line 28). Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to include the teachings of Yamamoto in the system of Yamada. Yamada’s system would easily be modified to incorporate Yamamoto’s teachings, as the systems share cumulative features, being additive in nature.

Conclusion

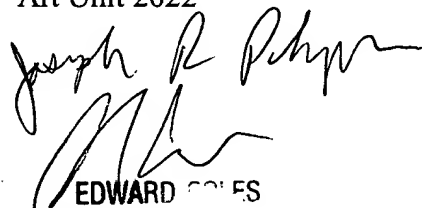
9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Joe Pokrzywa whose telephone number is (703) 305-0146. The examiner can normally be reached on Monday-Friday, 7:30-4:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Edward L. Coles can be reached on (703) 305-4712. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

jrp

Joseph R. Pokrzywa
Examiner
Art Unit 2622



EDWARD L. COLES
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